



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,739	07/31/2001	William J. Egan	PHARMA.003A	3949
20995	7590	12/24/2003	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP			SMITH, CAROLYN L	
2040 MAIN STREET			ART UNIT	
FOURTEENTH FLOOR			PAPER NUMBER	
IRVINE, CA 92614			1631	

DATE MAILED: 12/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

201
Advisory Action

Application No.

09/919,739

Applicant(s)

EGAN ET AL.

Examiner

Carolyn L Smith

Art Unit

1631

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: 3.

Claim(s) rejected: 3-8.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 2. NOTE: The previous claims were directed to a method of selecting a set of marker molecules, whereas the newly proposed amended claims are directed to "constructing a model for predicting molecular behavior using marker molecules" which is a new issue. Proposed claim 3 (lines 5-6) recite the phrase "receiving data related to one or more chemical or biological properties of a set of structurally defined reference molecules" which is another new issue. These new issues would require further consideration and/or search.

While the passages noted by applicants on pages 4 (lines 18-21) and 5 (lines 19-31) of the specification provide support for selecting a set of maker molecules all possessing the chemical/biological property of interest, this only provides support for a single property instead of the one "or more" properties as stated in proposed amended claim 3 (line 5). While the passage noted by applicants on 14 (lines 3-15) of the specification provides support for specific compounds that were excluded because they lack values or belonged to an unusual structural class, this does not provide adequate support for "receiving data related to one or more chemical or biological properties of a set of structurally defined reference molecules". In these passages, there is no support for "receiving data", "one or more ... properties", or the broadly encompassing phrase of "structurally defined reference molecules" as stated in proposed claim 3, lines 5-6. If the after final amendments had been entered, this lack of written basis would have resulted in a NEW MATTER issue.

While originally filed claim 1 provides support for classifying a set of reference molecules, there does not appear to be adequate support in the specification, figures, or claims as originally filed for classifying "the respective molecules in said set of reference molecules" as stated in proposed amended claim 3, lines 7-8. If the after final amendments had been entered, this lack of written basis would have resulted in a NEW MATTER issue.

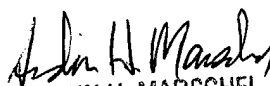
While originally filed claim 5 provides support for choosing molecules of a subset, there does not appear to be adequate support in the specification, figures, or claims as originally filed for "choosing said first molecule as a marker molecule if said first marker molecule has ..." as stated in proposed amended claim 3, lines 23-25. If the after final amendments had been entered, this lack of written basis would have resulted in a NEW MATTER issue.

While written basis is provided for repeating the process for all of the marker molecules (page 12, line 26), there does not appear to be adequate support in the specification, figures, or claims as originally filed for choosing steps "for other molecules of said subset" as stated in proposed amended claim 7, lines 2-3. The scope of the proposed amended claim which encompasses all or less than all other molecules differs from the scope of the written support which is only for all of the marker molecules. If the after final amendments had been entered, this lack of written basis would have resulted in a NEW MATTER issue..

Continuation of 5. does NOT place the application in condition for allowance because: of the presence of new issues which would require further consideration and search as well as the presence of NEW MATTER (see discussion above). If the proposed amendments had been entered, the objection of claim 3 would have been removed, the 35 USC 101 nonstatutory rejection would have been maintained, the 35 USC 112, first paragraph rejection of claims 5-8 would have been removed, and further search would be needed to determine if the 35 USC 102 rejection would be maintained.

Applicants submit the proposed amended claims would be statutory subject matter. This would be found unpersuasive as the claims appear to be directed merely to data manipulation. Applicants submit the amended portion of proposed claim 3 includes data of chemical and biological properties of reference molecules which must be obtained from the physical world. This would be found unpersuasive as proposed claim 3 can be broadly interpreted to mean receiving data from any source, including a database which could be located in and received from the computer as opposed to outside in the physical world. The remaining statements made by Applicants can be more broadly and reasonably interpreted then what the Applicants suggests which still qualifies the proposed amended claims in the nonstatutory category.

Applicants comments regarding the 35 USC 102 rejection are not addressed due to the presence of NEW MATTER and new issues in the proposed amended claims which would require further consideration and search.


ARDIN H. MARSCHEL
PRIMARY EXAMINER